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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,845

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Kyoichiro Iida

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

02/16/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,845	Applicant(s) IIDA ET AL.	
	Examiner REBECCA L. ANDERSON	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-95 is/are pending in the application.
- 4a) Of the above claim(s) 79,83 and 84 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 89-93 and 95 is/are allowed.
- 6) ☒ Claim(s) 77,87 and 88 is/are rejected.
- 7) ☒ Claim(s) 80-82,85,86 and 94 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 77-95 are currently pending in the instant application. Claims 77, 87 and 88 are rejected. Claims 78, 80-82, 85, 86 and 94 are objected. Claims 79, 83 and 84 are withdrawn from consideration as being for non-elected subject matter. Claims 89-93 and 95 appear allowable over the prior art of record.

Response to Amendment and Arguments

Applicant's amendment and arguments filed 13 December 2010 have been fully considered and entered into the instant application.

Applicants' amendment has overcome the objection to the specification as drawings were submitted on 13 December 2010.

As claims 77, 87 and 88 are rejected with prior art, the objection to these claims as containing non-elected subject matter is presented.

Applicants' cancellation of claims 9, 16, 17, 27, 34, 40-42 and 50 has overcome the objection to these claims for being in improper form.

The cancellation of claim 34 has overcome the 35 USC 112 2nd paragraph rejection.

The cancellation of claims 68-76 has overcome the 35 USC 101 rejection and 35 USC 112 2nd paragraph rejection of these claims.

The cancellation of claims 1, 8, 16-18, 25-29, 31, 54, 58-61, 68, 70, 71, 73, 74 and 76 has overcome the 35 USC 112 1st paragraph rejection of these claims.

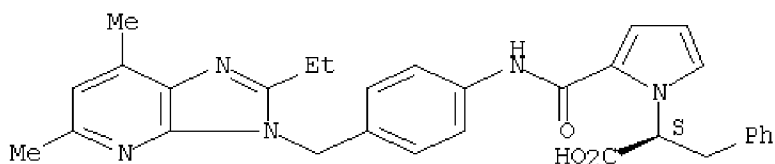
The cancellation of claims 1, 8, 9, 16, 25-29, 31, 33, 34, 40, 48-52, 54, 56-61 and 68-76 has overcome the 35 USC 102(b) rejection of these claims.

The cancellation of claims 17, 41 and 42 has overcome the 35 USC 103(a) rejection of these claims.

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-61 and 68-76 and the further election of the compound 127 in the reply filed on 26 April 2010 has been previously acknowledged.

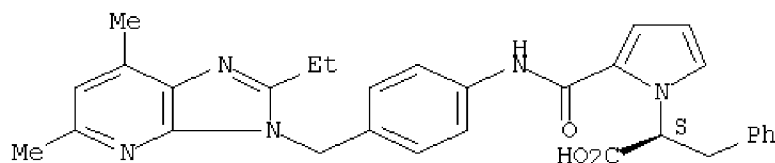
Applicants' elected species of compound 127 is now considered allowable. allowable. Therefore, according to MPEP 803.02, the search and examination of the claims has been extended to the subject matter of claims 78, 80-82, 85, 86 and 89-95 in their entirety which appears allowable over the prior art of record and further to the non-elected species:



which is not

allowable.

Claims 77, 78, 80-82 and 85-95 have been examined to the extent that they are readable on the elected embodiment, the elected species of compound 127, claims 78, 80-82, 85, 86 and 89-95 in their entirety and the non-elected species:



. Since the elected embodiment is not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration.

It has been determined that the entire scope claimed is not patentable.

Claim Objections

Claims 77, 87 and 88 are objected to as containing non-elected subject matter. Claims 77, 87 and 88 presented drawn solely to the elected embodiment identified supra would overcome this objection, as would an amendment to overcome the pending rejections of the claims as the examiner would then extend the search according to MPEP 803.02.

Claims 78, 80-82, 85 and 86 are objected to as being dependent upon a rejected base claim, but would appear to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 94 is objected to because of the following informalities: Claim 94 ends in two periods instead of only one. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

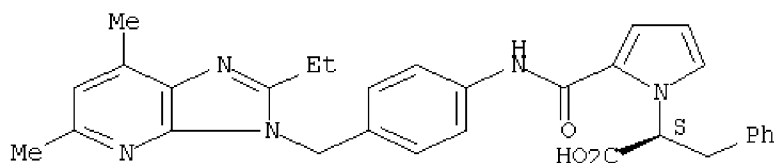
A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 77 and 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Sircar et al.

Sircar et al. discloses the compounds of Table VII, page 1739. The receptor binding affinities of the isomeric acids in Table VII were in the micromolar range (page 1739). A specific compound disclosed is the compound 61 in table VII:



. This compound corresponds to applicants claimed invention wherein R11e is substituted aromatic heterocyclic carbonyl; R35a is ethyl; R36a is methyl and R37a is methyl.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

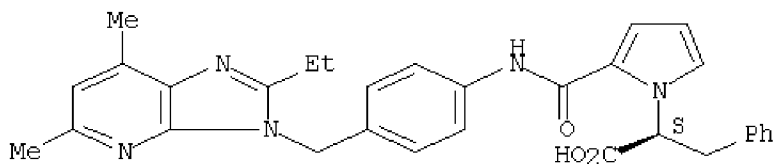
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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

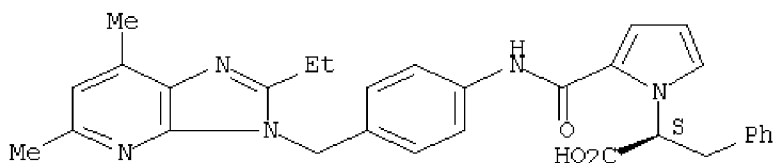
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sircar et al.

Sircar et al. discloses the compounds of Table VII, page 1739. The receptor binding affinities of the isomeric acids in Table VII were in the micromolar range (page 1739). A specific compound disclosed is the compound 61 in table VII:



. This compound differs from the instantly claimed invention in that R35a is ethyl instead of methyl. However, minus a showing of unobvious results, it would have been obvious to prepare the instantly claimed invention as the prior art provides the



species which differs only by the position equivalent to applicants' R35a. The motivation would be to prepare additional compounds which have similar receptor binding affinities. To those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare homologs of the compounds taught in the reference with the expectation of obtaining compounds which would have similar receptor binding affinities. Therefore, the instant claimed compounds would have been suggested to one skilled in the art. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity. According to MPEP 2144.08, compounds which are homologs are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

14 February 2011

Rebecca Anderson
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